Supreme Court, U.S.
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No. _____

In the Supreme Court of the United States

CITICORP MORTGAGE COMPANY INC., &
LUIS SORO

Petitioner,

v.

CITICORP

Respondents.

On Petition For Writ Of Certiorari
To The United States Court Of Appeals
For The Eleventh Circuit

PETITION FOR WRIT OF CERTIORARI

Luis Soro
INVENTOR, CREATOR, DESIGNER,
FABRICATOR, DEVELOPER,
CULTIVATOR, AND THE FIRST
USER OWNER SINCE JANUARY 05,
1976 THE TRADENAME CITIGROUP
MORTGAGE COMPANY
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QUESTIONS PRESENTED

Whether the Lower Courts erred because they did not apply the Doctrin of first use to the tradename Petitioner created, invented, developed, cultivated, and is the original first user owner of Citigroup (22) twenty-two years (January 05 1976) prior to Respondents first use on October 08, 1998.

Whether the Lower Courts erred when they failed to observe that confusion between service marks and similarty of appearance is determined on the basis of the total effect of the designation rather that on a comparison of individual features.

Whether the Lower Courts erred when they failed to realize that Petitioner has found over (2000) two thousand "CITI" users through out the United States since 1976. Respondents own attorney admits that "citi use is not new".

Whether the Lower Courts erred when they did not understand, and failed to apply the very clear trademark law use it or lose it to this (20) twenty year old case that has gargantuan "citi" use.

Whether the Lower Courts erred when they failed to understand that the right to a perticular mark grows out of use, and not it's mere adoption.

Whether the Lower Courts failed to recognized that the courts have traditionaly tolorated a greater degree of resemblence among the names of financial institutions.

Whether the Lower Courts failed to relize that this Supreme Court of the United States recognized there is no such thing as property in a trademark except as a right appurtenant to an established business or trade in connection with which the mark is employed, Over (70) seventy years ago.

PARTIES TO THE PROCEEDING

The following, and no others, are parties to the instant proceedings:

Petitioner LUIS SORO, an indivdual, and president and sole share holder of the Defendant CITICORP MORTGAGE COMPANY INC., since it was formed on December 15, 1979.

Respondents Citicorp is a Delaware corporation doing business in Florida since 1984.

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PETITION FOR WRIT OF CERTIORARI

Petitioner Respectfully seeks certiorari to review the opinion by the Eleventh Circuit Court of Appeals entered November 02, 2004, [Appendix B] and a timely submition of a Petition for Rehearing and Request for Rehearing En Banc, which were denied December 21, 2004 [appendix A].

I.

CITATIONS TO OPINIONS BELOW

The opinion of the Eleventh Circuit Court of Appeals in Citicorp v. Citicorp Mortgage Co., Inc., & Luis Soro (not selected for publication in the federal reporter) (Nov. 2 2004) [Appendix B page 4].

The Order denying the Petition for Rehearing and Request for a Rehearing En Banc was entered on December 21, 2004. [Appendix A], the Judgment was entered against the Defendants by the District Court Southern District if Florida on March 30, 2004, also unpublished [Appendix C page 12] The pertinent rulings appear in the attached as noted.

II.

JURISDICTIONAL STATEMENT

The District Court for the Southern District of Florida had subject matter jurisdiction pursuant to Section 43 (a) (1) of the Lanham act of 1946, 15 U.S.C. 1125 (a)(1) unfair competition under Florida common law, and injury to business reputation under Florida Statutes 495. 151, this being an action for deglatory reliefdue to Plaintiff's invasion of Defendant's home turf state of Florida.

On September 8, 1987, the District Court for the Southern District of Florida entered Summary Final Judgment on all counts in favor of Plaintiff in violation of rule 37 CFR 10.14 (e) [Appendix F]

Petitioners herein appealed the District Court's Order on behalf of both himself and Citicorp Mortgage Company Inc. and himself President Luis Soro, over which the Eleventh Circuit had jurisdiction pursuant to 28 U.S.C. §1291, granting the courts of appeals jurisdicition over appeals from all final decisions of the district courts of the United States.

The Eleventh Circuit dismissed the appeal as to the Florida Registered and licenced corporation Citicorp Mortgage Company Inc. for lack of jurisdiction, because the corporation was not represented by an attorney in error, see 37 C.F.R § 10.14 (e). With Respect to the President of the corporation Luis Soro the District Court's judgement was reversed and it was remanded for further proceedings. The lower courts did not apply the doctrin of first use, to the name Pititioner invented over (29) twenty nine year ago and the over (2000) two thousand "citi" users that have been found.

Defendants/Appellants filed a timely petition for rehearing and a petition for rehearing en banc that were denied and no Judge in regular active service on the Court having requested that the Court be polled on rehearing en banc both of the petitions were denied on December 21, 2004.

III.

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

The First Amendment to the United States Constitution:

> Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the government for a redress of grievances.

The Fourteenth Amendment to the United States Constitution, Section 1:

> Section 1. All persons born or naturalized in the United States and subject to the jurisdiction thereof, are citizens of the United States and of the state wherein they reside. No state shall make or enforce any law which shall abridge the privileges or immunities of citizens of the United States; nor shall any state deprive any person of life, liberty, or property, without due process of law; nor deny to any person within the jurisdiction the equal protection of the laws.

IV.

STATEMENT OF THE CASE

A. Summary of Facts

Defendant Luis Soro is the registered and licensed president and sole shareholder of the licensed and registered Defendant Citicorp Mortgage Company Inc., since it was incorporated on July 07, 1981, a licenced mortgage broker and owner since it was formed on December 15, 1979.

Defendant Luis Soro is the creator, inventor and the original first user owner of Citigroup Mortgage Company since it was manufactured on January 05, 1976 and has never been incorporated to this date.

Defendant Luis Soro made his first mortgage loan over (40) forty years ago on March 1965 and has made over 15,000 loans since, over 10,000 ten thousand mortgage loans using the Citigroup tradename since 1976 through the world.

On or about 1984 Respondend entered the Petitioners state of Florida inviolation of both federal and state of Florida banking rules to save a failed savings and loan

Biscayne Federal. On or about August 1985 Respondent sued the Pititioner for trademark infringment for using a name that was invented (8) eight years prior Respondent entered the state of Florida. This is a trademark case, and rule 37 CFR 10.14 (e), if a party electing to represent itself is a corporation or an association, the party may act through any individual who is an officer of the party and who is authorized to represent it. I Luis Soro was not permitted to file any papers to defend my corporation in this trademark case in violation of rule 37 CFR 1014 (e), and nothing was ever said about one of my other companies Citigroup Mortgage Company.

The violation of rule 37 CFR 10.14 (e) resulted in a summary Judgment without a jury trialand this case ended. On or about October 08, 1998 Respondent started using one of Petitioners (22) twenty two year old tradename Citigroup. Pititioner filed a cancellation case number 31,572 at the United States Patent and Trademark office on November 22, 2000, one (1) day after the Respondent fraudulently registered my mark on November 21, 2000.

The tradename Citigroup invented and cultivated by Luis Soro that did not mean anything until I gave it a meaning is as close to Respondent's mark Citicorp as Wal-Mark is to Wal-Greens, Goodyear tires is to Goodrich tires, General Motors is to General tires to General Electric, to General Mills to General Rental, to General Nutrition, American Airlines to American Express, American Cargo Express, American Red Cross, to American Coin Exchange to American Cancer Society, to American Heart Association.

The name citigrada and citigrade are found in the dictionary that have nothing to do with Respondent or Petitioner. The Petitioner has found over (2000) two thousand "citi" users since 1976 all over the United States and beyond, that have nothing to do with the Respondent or the Pititionerand the lawyer for the Respondent agree with the Pititioner that "citi use is not new". Pititioner has innumerable (∞) business owners that use the mark cities, city, citi, or cit in their tradenames have been found.

The word city or cities is a noun, it discribes a place or thing, phoneticly cities is the plural of city, and the undisputed facts that we have traditionaly tolorated

a greater degree of resemblence anoung the names of financial institutions only reinforces this conclusion.

This Supreme Court of the United States recognized over (70) seventy years ago that there is no such thing as a property in a trademark except as a right appurtenant to an established business or trade in connection with which the mark is employed. Use it or lose it should be a guiding principal for trademark owners, and the right to a particular mark grows out of use, not its mere adoption.

The Honorable Joan A. Leanard wrote in her opinion "as it is undisputed that Soro has been using the name Citigroup name since at least the mid 1990's"...based on case facts, meaning 1994-1995 giving Luis Soro "FIRST USE" The district court misapprehended the law and that is reviewed under the clearly erroneous standerd of Fed. R. Civ. P. 52 (e).

Respondent's own attorney in a signed declaration and after being warned that willful false statements and the like so made were punishable by fine or imprisonment

or both under U.S.C. § 1001, and that such willful false statements my jeopardize the validity of this document, Stated on June 15, 2000 "the mark was first used on the goods or services anywhere at least as early as April 6, 1998 and in commerce at least as early as October 8, 1998". Signed by Anne Moses, Assistant Secetary.

The Eleventh Circuit rejected Luis Soro's repeated claims that he was the first user of the mark "Citicorp" and had a right to the term. They also wrote "these contentions are not relevant to the issue of this case". First use is very relevant to a trademark case because first use or senior use gives ultimate rights to the use of that particular mark. Use is not only essential to establishing rights in a particular mark, continued use is essential to preserving rights in a mark.

In determining likelihood of confusion service marks, similarty of appearance is determined on the basis of the total effect of the designation rather that on a comparison of the individual features, between service marks,and a federal registration is not need for a service mark to establish rights.

Pititioner has twenty two (22) years prior use of his invented tradename before Respondent hijacked the mark Citigroup on October 8 1998.

B. THE CHALLANGED LAWS

Granting Plaintiff's motion to find Defendant Luis Soro in Contemt of Court. and awarding Plaintiff's Application for Attorney's Fees in Part.

More than twenty years ago the Plaintiff entered the State of Florida to save a failed Savings and Loan Biscayne Federal, in violation of both federal abd State of Florida banking Laws, just to save money for the F.D.I.C.

In August 1985 after entering the State of Florida, Sued a Florida company that was incorporated in 1981 Citicorp Mortgage Company Inc., and the corporate President Luis Soro, for trademark infringment, false designation of origin, injury to business reputation, and unfair competition in the state they had entered the year before.

a. Defendant Luis Soro has been funding loans under the name Citigroup Mortgage Company since January 05, 1976

b. Creator and inventor of a name has ultimate rights to that name, Pititioner is First User.

c. He has paid the corporate fee to the State of Florida every year since 1981, to date, 2005

Defendant has ultimate rights to Citigroup,

V.

REASONS FOR GRANTING THE PETITION

A. Summary of Argument and Introduction

The Eleventh's Circuit opinion in this case is a study in contradiction and an utter rejection of this Court's and other court's clearly established principals of trademark and First Amendment law. See Moseley v. V. Secret Catalogue Inc. 123 S. CT. 1115 (Mar. 04, 2003). Surf Club

It is a well established law that first user or inventor or creator has the the ultimate rights to that name. It is also a well established and undisputed facts that we have traditionaly tolorated a greater degree of resemblence among the names of financial institutions. Sun Banks v. Sun Federal 651 F.2. 331 (5th Cir. 1981), First Southern Federal v. First Southern Savings 614 F.2d. 71 (5th Cir. 1980), Fidelity Bond v. Fidelity Bond (37 F.2d 99 (5th Cir. 1930). Sun Bank V. Sun

While both Appellants and Appellees in this case for almost (20) twenty years have been in litigation it must come to an end at some point, and that point is now. Continental Bank v. State of Fl. S.Ct.

The court's below in this case have completely disregarded the entire set of issues on First Amendment procted activity to effectively prohibit an entire category of speech in a public forums, first use of an invented and created tradename, and the violation of rule 37 C.F.R. 10.14 (e) that gives the right to a corporate President to represent his corporation in trademark or tradename litigation.

Although the decision is unpublished, the Eleventh Circuit should not be allowed to use the mechanism of an unpublished decision to completely disregard the well established principales of the First Amendment law and the First User or the inventor or creation of a tradename, that has been used in interstate commerce and trade since January 5, 1976.

B. A FEDERAL REGISTRATION IS NOT NEED FOR A MARK TO ESTABLISH RIGHTS TO A PARTICULAR MARK

Appellant contended on appeal that because he was the inventor, creator, manufacturer, designer, fabricator, cultivator and the original first user owner of CITIGROUP Mortgage Company since January 5, 1976 that he had ultimate rights to the term "Citigroup". Appellants also condended that not even with gargantuan speculation, would he have been able to

predicate that in 1985 Appellees would violate both Federal and State of Florida banking rules and laws and enter Appellants home state where his corporate name was registered and licenced, and be involved with Appellee in litigation for the past (20) twenty Years. See. Home Savings v. Home Savings of America, also Continental Bank Corp., v. The State of Florida 87-1955, then On October 8, 1998, that Appellee hijack one of Appellant's other name.

The Eleventh Circuit did not address these assertions, but simply concluded that:

After reviewing the record, we conclude that the district court did not abuse its discretion in finding Soro in contempt for violating the permanent injunction. First, the evidence showed that Soro Violated the specific prescriptions of the injunction by submitting to the Trademark Trial and Appeal Board a flier for the company Citicorp Mortgage,"' using the exact term, "Citicorp" that the court had enjoined him from using. Additionally, Soro repeatedly used the term Citigroup" in connection with his mortgage business, when the permanent injunction prohibitedhim from using any similar to "CitiCorp" that was likely to cause confusion with Citicorp's mark or to mislead the public into believing Soro and Citicorp were affilated.

First User has ultimate rights to a name and reasonable people know the difference Wal-Mart and Wal-greens, Office Depotand Office Max, General Motors and General Electric and General Tire ect.,

Respondent can not possible have any rights to a name they started using over twenty two (22) years after Petitioner invented and created his tradename that has been used in international trade since January 5, 1976.

Most Namess or tradenames are not registered in fact an attorney from the trademark office wrote in a published newspaper "If every name in America was trademarked we would need twenty buildings like these". He was refering to the twin 14 story towers in Crystal City, Va. That is why First user has ultimate rights no matter who the litigants are.

C. In Trademark Law The First User Has Ultimate Rights to that tradename whether it is registered with the Trademark or not.

The law of trademarks is but a broader law of unfair competition; the rights to a particular mark grows out of it's use, not its mere adoption; and is not the subject of property except in the connection with an existing business. The Respondent invaded Pititioner's home state nine years after first use of Citigroup by the Pititioner, and started using his name twenty two (22) years after its creation and use in international trade. AS part of the event that have occured

since October 8, 1998, Respondent has also hijacked part of Petitioner's Logo the Crecent Moon (☾) that now Respondent uses the claim as an umbrella.

Use is essential to trademark protection you have to use it or you lose it. Use is not only essential to the establishing of rights in a tradename, the continued use is essential to preserving rights in a tradename. The Respondent do not have any rights to Petitioner's invented name and should be Ordered to be cancelled by this Court. Respondent has had fraudulent use of Petitioner's mark Citigroup since October 8, 1998.

D. Cancellation of the registration for the Mark Citigroup obtained on November 21, 2000, Number 2406753 should be ordered by this Court.

The Fradulently obtained registration of the mark Citigroup on November 21, 2000, should be ordered cancelled, at the Trademark office. Pititioner on November 22, 2000, one day after Respondent fraudently registered his mark filled a cacellation case number 31,572 at the (PTO) for the mark Citigroup. The name or tradename is a valuable asset because it is the "good will" of a business. The pitioner has (29) twenty nine years of

good will in Citigroup and (22) twenty two years of prior use of the Citigroup mark before Respondents first use on October 8, 1998 [Appendix F].

In general the scope of a trademark search varies widely, it can include one or all of the following: phone books (major cities) state registrations, market directories, domaine names, trade listings. The clearing of a mark for use is one of the most difficult aspects of trademark practice. Respondent claim that they "DID NOT DO ANY TRADEMARK SERCH BECAUSE THERE WAS NO TIME". This is where the problem starts. Since 1976 Pititioner has checked 411 and the phone books and until 1998 not one Citigroup user was found, although over (2000) two thousand "Citi" users have been found, even in the dictionary citigrada, and citigrade. Generally it is advisable to do a full serch. Respondent has spent thousands of dollars on this case and not a dollar on trademark or tradename serch because they knew of Pititioner's prior use of the tradename Citigroup. This Petitioner has spent a gargantuan amount of time and money defending his tradename that has been used for the past (29) twenty nine years in international trade, that have been continuous. Judge Leanard ruling "As it is undisputed that Soro has been using the "Citigroup" name since at leat the mid 1990"s...". (R-5-232-12) That gives Luis Soro "First Use with Ultimate Rights.

E. This Supreme Court of the United States Recognized there is no such thing as property in a tradename or trademark except as a right appurtenant to an established business or trade in connection with which the mark is employed.

Use it or lose it should be a guiding principal for tradename or trademark users or owners. Delaware & H.Canal Co. v. Clark, 13 Wall. 311, 322, 20L.ed 581, 583; Mclean v. Fleaming, 96 U.S. 245, 254, 241.ed. 828, 832. This Supreme Court of the United States recognized over (70) Seventy years ago there is no such thing as property in a trademark execpt as a right appurtment to an established business or trade in connection with which the mark is employed.

Respondent can not possibly have any rights to the name Pititioner invented, created, manufactured, developed, fabricated, and has cultivated since January 05, 1976. The right to a particlar mark grows out of use, not its mere Adoption. Respondent has Fraudulently adopted Pititioners tradename and this Court shoud order them to cease and desist from using the name "Citigroup" immediately and destroy all documents bearing the Citigroup and pay Pititioner treble profits since October 08, 1998. Moseley v. V. Secret Catalogue Inc., 123 S. Ct. 1115 (mar. 04, 2003).

F. Pititioner is not in Contempt of Court because he was the orginal first user owner of Citigroup and has Ultimate rights to that tradename.

The lower courts did not apply the doctrin of "first use" of the tradename Citigroup that was invented and used since January 05, 1976, and has ultimate rights. In 1985 when this case was first filed the district violated rule 37 C.F.R. 10.14.(e) because it did not provide the Defendant Luis Soro who is the Corporate President to represent his corporation in a trademark case dispite the well known rule.

Pititioner Luis Soro is the President of the registered Florida coprporation Citicorp Mortgage Company Inc., since July 07, 1981, d/b/a as Soro Mortgage Company Inc., and has nothing to do with one of other companies Citigroup that was invented on January 05, 1976, and has never been incorporated.

Petitioner is a licenced and registered mortgage broker that has been inlitigation with Respondent over a tradename that was used by the Pititioner over (22) twenty two years before Respondents first use on 10-08 1998. [Appendix G] and the fact that we traditionaly tolorated a greater degree of resemblence amoung the names of financial institutions only reinforces this conclution.

G. Attroney's fees are not permitted under the Lanham Act except in exceptional cases and the District Court Abused its discreation in Awarding Attorney's Fees in this Trademark infringing Case that is over (20) Twenty Years Old and Pititioner's Invented Name was Hijacked on October 08, 1998.

The district court abused it discreation in awarding attorney's fees in this trademark infringment case under the Lanham Act, 15 U.S.C. § 1051 et seq. that is over twenty (20) years old for a name Pititioner invented and has cultivated for the past (29) twenty nine years of undisputed and uncontested continued first use of the trade name Citigroup in local and international markets since January 05, 1976.

The Pititioner has been charged with civil contempt for using his invented 29 year old name that he invented, the Judge ruled that "As it is undisputed that Soro has been using the "Citigroup" name since at least the mid 1990's...". giving Luis Soro first use, and the Respondent's own attorny's writing that "Citi use is not new" in a motion to the district court, and the Petitioner agree with Respondent and has found over Two thousend (2000) "Citi" users since 1976, that same name Respondent has litigated with Pititioner for over the past twenty years, at a gargantuan cost.

VI.

CONCLUSION

Petitioner contends that in a number of ways, the Eleventh Circuit's opinion in this case conflicts with the precedent set by this Court and that of the other circuits, creating a decision that is fundamently wrong and that severely chills the rights of those who engaged in what has consistently been held to be First Amendment protection and protected speeh activity and the right of first use of an invented, created, and the cultivation of a (29) twenty nine year old tradename, and improperly upholds a law that substantialy restricts First Amendment Protected activity in publis forums.

Based on all of the foregoing, the Petitioner Respectfully submits that a grant of certiorari is appropriate.

DATED: April 19, 2005

Respectfully submitted,

Luis Soro, President
CITICORP MORTGAGE CO., INC.,
INVENTOR, CREATOR, DESIGNER,
FABRICATOR, DEVELOPER,
MANUFACTURER, CULTIVATOR,
AND THE ORIGINAL FIRST USER
OWNER SINCE JANUARY 05, 1976
OF THE TRADENAME CITIGROUP
MORTGAGE COMPANY
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APPENDIX A

UNITED STATES COURT OF APPEALS

FOR THE ELEVENTH CIRCUIT

No. 04-11757

CITICORP

Plaintiff-Appellee

versus

CITICORP MORTGAGE CO., INC.,

Defendant,

LUIS A. SORO,

Defendant-Appellant,

On Appeal from the United States District Court for the Southern District of Fl

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ON PETITION (S) FOR REHEARING AND PETITION(S) FOR REHEARING EN BANC

Before: ANDERSON, DUBINA, AND WILSON

PER CURIAM:

The Petition(s) for Rehearing are DENIED and no Judge in regular active service on the Court having requested that the Court be polled on rehearing en banc (Rule 35, Federal Rules of Appellate Procedure) the Petition(s) for Rehearing En Banc are Denied.

ENTERED FOR THE COURT:

Filed and entered December 21, 2004

APPENDIX B

IN THE UNITED STATES COURT OF

APPEALS FOR THE ELEVENTH CIRCUIT

No. 04-11757

Non-Argument Calender

D.C. Docket No. 85-02960-CV-JAL

CITICORP,

Plaintiff-Appellee

versus

CITICORP MORTGAGE CO., INC.,

Defendant

LUIS A. SORO

Defendant-Appellant,

Appeal from the United States District
Court for the Southern District of Florida

NOVEMBER 2, 2004)

Before ANDERSON, DUBINA AND WILSON,
Circuit Judges.

PER CURIAM:

Appellant, Luis Soro, proceeding pro se, appeals the district court's orders finding him in contempt of court and awarding attorney's fees to movant Citicorp. The initial litigation in this case originated in 1985, when Citicorp sued Soro for trademark infringement under the Lanham Act, 15 U.S.C. § 1051 et seq. At that time, the district court permanently enjoined Soro from using the term "Citicorp," or any term similar to "Citicorp" that was likely to cause confusion with Citicorp's mark or to mislead the public into believing Soro and Citicorp were affiliated. In 2002, Citicorp filed a motion asking the district court to find Soro in contempt of court for violating the permanent injunction. It is from 3the the district court's grant of this motion and its subsequent award of attorneys' fees to Citicorp that Soro now appeals. On appeal, Soro argues that the district court abused its discretion in (1) granting Citicorp's motion to find him in contempt of court, and (2) granting Citicorp's application for attorneys' fees. We address these issues in turn.

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A. CONTEMPT OF COURT

Soro argues that the district court should have applied the doctrine of "first use" and declared that he had the right to the term "CitiCorp" because he had been using it since 1976, well before Citicorp began using it. He also asserts that "Citigroup" is a safe distance from "Citicorp" and reasonable people would be able to tell the two companies apart. He contends that the district court erred in failing to order the Patent and Trademark Office ("PTO") to cancel Citicorp's registration of the "Citigroup" mark, and asks this Court to cancel the registration.[1]

We review a district court's finding of civil contempt for an abuse of discretion. Howard Johnson Co. v. Khimani, 892 F. 2d 1512,1516 (11th Cir. 1990)(citations omitted). "[I] f the evidence is such that a reasonable person could find a clear and convincing violation of the preliminary injunction, [this Court] must affirm the contempt ruling." Id.

In a civil contempt proceeding, the party moving for a finding of contempt bears the burden of establishing by "clear and convincing [evidence] that the underlying order was violated ." Id. (citiations omitted). If

"the moving party makes a prima facie showing that the court order was violated, the burden of production shifts to the [party allegedly in contempt] to show a present inabilty to comply that goes beyond a mere assertion of inability." Id. (internal quotations and citations omitted). The court should not focus on the subjective beliefs or intent of the party allegelly in contempt, but rather whether in fact the party's conduct complied with terms of the order. Id.

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[1]This final contention is meritless. The proper procedure for cancellation of a trademark registered by the PTO is a cancellation proceeding. See 15 U.S.C. § 1064. The proper vehicle for a request for an order to compel an action would be a petition for writ of mandamus. See 28U.S.C.§§ 1361, 1651. The district court lacked jurisdiction to cancel the PTO proceeding as does this court. Soro neither requested nor was entitled to mandamus relief on this issue either in the district court or in this court. See id.

A party who has previously been found guilty of infringing on the trademark rights of others and who has been enjoined from engaging insuch activity faces a higher burden to avoid colorable imitation or dilution of the mark than a party not previously so enjoined. Id at 1517. Those

that have been enjoined are required "to keep a safe distance away from the dividing line between violation of, and compliance with , the injunction. They must do more that see how close they can come safely to that which they are enjoined from doing." Id. (quotation and citations omitted).

After reviewing the record, we conclude that the district court did not abuse its discretion in finding Soro in contempt for violating the permanent injunction. First, the evidence showed that Soro violated the specific prescriptions of the injunction by submitting to the Trademark Trial and Appeal Board a flier for the company "Citicorp Mortgage," using the exact term, "Citicorp," that the court had enjoined him from using. Additionally, Soro repeatedly and undisputedly used the term "Citigroup" in connection with his mortgage business, when the permanent injuction prohibited him from using any term similar to "Citicorp" that was likely to cause confusion with Citicorp's mark or to mislead the public into believing Soro and Citicorp were affiliated. As a person who previously had been enjoined for violating Citicorp's intellectual property rights, Soro was

required "to keep a safe distance from the dividing line between violation of, and compliance with, the injunction." See Howard Johnson, 892 F.2d at 1517. He failed to do so.[2]

[2]We reject Soro's repeated claims that he was the first user of the mark "Citicorp' and therefore had right to the term. These contentions are not relevant to the issue in this case. The issue in the district court was whether Soro violated the terms of the permanent injuction by using the name "Citicorp ," when the injunction specifically prohibited him from using any term confusingly similar to "Citicorp," The issue was not whether Citicorp had established the right to use the term "Citigroup." Soro's arguments that he was the first user of the term "Citigroup" are irrelevant to the determination of whether his use of that term violated the prohibitions in the permanent injunction.

B. Attorneys' Fees

Soro asserts that the district court abused its discretion in awarding attorneys' fees he was entitled to use the term "Citigroup" He asserts that the Lanham Act does not permit an award of attorneys' fees except in the exceptional case. He does not, however, contest the amount of fees awarded.

An award of attorneys' fees in a civil contempt action is "within the district court's discretion." Sizzler Family Steak Houses v. Western Sizzlin Steak House, Inc., 793 F.2d 1529, 1534 (11 th Cir. 1986) (citation omitted). Such an award is reveiwed for an abuse of that discretion. See id. at 1535-36. In a civil contempt action, "reimbursement to a prevailing movant may include expenses reasonably and necessarily incurred in the attempt to force compliance.' Id at 1534-35 (internal quotations and citation omitted).

After reviewing the record , we conclude that the district court did not abuse its discretion in awarding attorney's fees to Citicorp. Citicorp submitted

declarations of its attorneys and billing records to chow that amount requested represented the expenses it reasonably incurred to enforce the injunction. Although Soro did not contest the amount requested, the district court specifically reviewed the submitted records and reduced the award to account for the nature of the work, the experience of councel, and local markey rates. It cannot be said that the district court abused its discretion in granting the application for attorneys' fees, especially considering that Citicorp has had to litigage this matter with Soro for almost 20 years.

Soro's argument that attorneys' fees were not permitted under the language of the Lanham Act is Flawed. While Soro is correct that the Lanham Act Provides that the district court may award reasonable attorneys' fees in "exceptional cases," that Act pertains to initial trademark infringement determinations. See 15 U.S.C. § 1117(a)(outlining process for awarding attorneys' fees in initial trademark

infringement action). The instant proceeding was not an initial trademark infringment but but a civil contempt action for violation of a permanent injunction previously entered. The standards for awarding attorneys' fees in such a proceeding are outlined above, and an award of attorneys' fees was within the district court's discretion. See Sizzler Family Steak House, 793 F.2d at 1534-36

For the foregoing reasons, we affirm the district court's contempt order and its order awarding attorneys' fees.

AFFIRMED.

APPENDIX C

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

CITICORP,

Plaintiff

vs.

CITICORP MORTGAGE COMPANY IN., and LUIS SORO, and individual

Defendants,

ORDER ADOPTING MAGISTRATE'S REPORT & RECOMMENDATION AND GRANTING PLAINTIFF'S MOTION TO FIND DEFENDANT LUIS SORO IN CONTEMPT OF COURT

THIS CAUSE is before the Court on the Report and recommendation ("R & R") of U.S. Magistrate Judge Andrea M. Simonton, issued March 26, 2003 (D.E. 228). Defendant Luis Soro filed Objections on March 28, 2003. Plaintiff Citicorp filed a Responce on April 16, 2003. Having conducted a de novo review of the record, the Court finds as follows:

I Introduction

Judge Simonton"s Report contains a thorugh and procedural history of this case, (R & R at 1-5). Thus, only the immediately pertinent details will be summarized here. In the underlying case, which began more than seventeen years ago, Plaintiff Citicorp

alleged that Defendants Citicorp Mortgage Company and Luis Soro had committed various acts of trademark infringement, false designation of origin, unfair competition, and injury to business repuation, by conducting business as "Citicorp Mortgage Company". On September 8, 1987, Judge Spellman entered a Summary Final Judgment in Plaintiff's favor and permanently enjoined Defendants Citicorp Mortgage and Soro from directly or indirectly using "Citicorp" or any other name or confusingly similar mark, in connection with any business owned or operated by Defendants. On remand, Judge Spellman again granted summary judgment against Defendant Soro on October 6, 1988. (See R &R at 4 for judge Spellman's finding of fact). After Defendant Soro failed to comply with the Court's order, he was arrested and held in contempt on November 28, 1988. To purge himself from contempt, he changed the business name from Citicorp Mortgage Company to Soro Mortgage Company in November, 1988.

On January 5, 1999, Soro filed a Motion Advising Court of Change of Name, stating that he would be changing his corporate name back to Citicorp Mortgage Company, based on Plaintiff's abandonment of the name "Citicorp" and Plaintiff's use of the name "Citicorp" after the merger between Citicorp and Traveler's Insurance Group Inc. (D.E. 161). On March 22, 1999,

Magistrate Judge Turnoff denied the Motion, based on Soro's failure to present evidence that Plaintiff had abandoned its trademark. (D.E. 164).

On April 3, 2002, Plaintiff filed the instant Motion to find Soro in Contempt of Court for violation of the permanent injunction entered on October 7, 1988, based on Soro's use of the names "Citicorp". (D.E. 173) Plaintiff submitted documentary evidence, including several declarations, to Show that Soro had been using the mark "Citigroup" in connection with a mortgage brokering business. Plaintiff argues that Soro"s use of the mark "Citigroup" violates the permanent injunction because "Citigroup" is not a safe distance from the mark "Citicorp" Plaintiff seeks a Order: (1) finding that Soro's use of the name and MARK "Citigroup" or any other name or mark that includes the term "Citi" for banking, mortgage, or real estate services violates the Injunction; (2) finding Soro in contempt; (3) enjoining Soro from prosecuting a pending Cancellation proceeding with the United States Patent and Trademark Office ("PTO"); (4) awarding Citicorp its reasonable attorney's fees and costs in investigating and defending the Cancellation Proceeding and in making this Motion; (5) awarding Citicorp Soro's profits, if any, from his use of CITIGROUP or any other Citi mark.

In the instant case, by contrast Soro proffers that he chose the "Citigroup" name based on the initials of former girlfriends. Pl.'s Ex. 25 at 2, 13.) The Court agrees with the late Judge Spellman that this explanation "strains this Court's imagination (and most likely would strain that of any reasonable person)". Pl's Ex. 1 at 8). As Soro has not proffered any reasonable explanation for his choise of the name "Citigroup" the Court finds that he employed the name with the intent to profit from the goodwill and business reputation that the Plaintiff has developed over the course of many years. Moreover, the CIT GROUP courtfound that, "As a result of the advertising and enormous scope of Citicorp's financial services activities, the "CITI" name is world famous.... It is this prefix which is dominant when used with another name or term and which identifies the source of the service or product." Id. at 783. This language only strengthens the Court's conclusion that the use of "Citigroup" in relation to financial and/or mortgage services is confusingly similar to "CITICORP" due to the identical prefix. Finally, the Court finds that the Supreme Court's recent holding in Mosely v. V. Secret Catalogue, Inc., 123 S. Ct. 1115 (Mar 4, 2003) holding that the Federal Trademark Dilution Act requires a showihg of actual dilution, rather than a likelihood of dilution), is irrelevant to the issues sub judice, because that case involved trademark dilution, rather than infringement or violation

of an injunction.

Based upon a de novo review of the hearing transcript (Pl.'s Resp. to def.'s Obj.Ex. 2) The Court concurs with Judge Simonton's conclusions regarding the lack of credibility of Soro's testimony. In view of Soro's proven proclivity to argue every possible angle of this case and to hurl accusations at Plaintiff at every opportunity, the Court does not believe that Soro has been using the Citigroup name since 1976 or that he attempted to advice Judge Spellman of such but Judge Spellman would not let him speak. Given tjhe dearth of any documentary evidence to show that Soro used the "Citigroup" name beginning in 1976 or when the Injunction was issued, and his failure to advice the Court that he was using the name "Citigroup" in his 1999 Motion Advising Court of Name Change, the Court discredits Soro's testimony on this issue. This finding is not crucial to the finding of contempt, however, because as explained above, the Court finds that Plaintiff did not keep a "safe distance" from the name "Citicorp" when using the name "Citigroup" Mortgage Company, As it is undisputed that Soro has been using the "Citigroup name since at least the mid-1990's, the Court finds that Soro has violated the injunction, and Plaintiff is entitled to the relief it seeks. Accordingly, it is

ORDERED AND ADJUDGED that:

1. The Report and Recommendation of U.S. Magistrate Judge Andrea M. Simonton (D.E. 228) issued March 26, 2003, is ADOPTED.

@. Plaintiff's Motion to find Luis Soro in Contempt of Court (D.E. 173), filed April 3, 2003, is GRANTED.

3. Defendant Luis Soro shall (a) immediately cease and desist from using the "Citigroup" name; (b) destroy all documents bearing that name; (c) pay to Plaintiff all profits earned as a result of the use of the name "Citigroup"

4. Defendant Soro shall pay reasonable attorney's fees and the costs of this litigation.

5. The parties shall confer within ten (10) days from the date of this order in an attempt to reach an agreement with respect to the above amounts to be paid. If no agreement is reached, Plaintiff shall file a motion to determine the amounts within thirty (30) days from the date of this Order.

DONE AND ORDERED in Chambers at Miami, Florida this 14 day of May, 2003.

JOAN A. LENARD
UNITED STATES
DISTRICT JUDGE

APPENDIX D

IN THE UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

No. 87-5884
Non-Argument Calendar

CITICORP,

Plaintiff-Counter Defendant
Appellee,

versus

CITICORP MORTGAGE COMPANY, INC.,

Defendant-Counter Plaintiff
Appellant.

Appeal from the United States District Court
for the Southern District of Florida

(June 30, 1988)

Before HILL, FAY and VANCE, Circuit Judges.

PER CURIAM:

In this action for trademark infringement defendants Citicorp Mortgage Company, Inc. (Citicorp Mortgage) and Luis A. Soro appeal from the district court's grant of summary judgment for plaintiff Citicorp. We dismiss Citicorp Mortgage's appeal for lack of jurisdiction. As to Soro, we reverse.

In August 1985 Citicorp brought this action under the Lanham Act, 15 U.S.C. §§ 1051-1127, and Florida statutory and common law. Citicorp Mortgage and Soro counterclaimed, seeking damages for tortious interference

with contractual relationships. In March 1987 Citicorp filed a motion for summary judgment. At the same time the parties filed a joint motion to have the court modify its existing scheduling order so that it could first address Citicorp's motion for summary judgment. In the motion the parties agreed that the defendants would have at least thirty days to respond to the motion for summary judgment. They also agreed that the defendants could have additional time if reasonably needed to conduct further discovery.

By June the defendants had not filed a response to Citicorp's motion for summary judgment. On June 19 the magistrate denied the defendants' motion to enlarge the time to respond and recommended that the motion for summary judgment be granted by default. The district court accepted the magistrate's recommendation and on September 9 entered summary judgment in favor of Citicorp both on its claims and on the defendants' counterclaims. Following the court's entry of judgment Soro brought this appeal *pro se* on behalf of himself and Citicorp Mortgage.[1]

At the outset we must address a jurisdictional problem. Soro, who is not a lawyer, filed Citicorp Mortgage's notice of appeal and is attempting to represent the corporation *pro se*. It is well settled in this circuit that a corporation must be represented by counsel. *Palazzo v. Gulf Oil Corp.*, 764 F.2d 1381, 1385 (11th Cir. 1985), *cert. denied*, 474

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[1] In April 1987 the attorney for Citicorp Mortgage and Soro had filed a motion to withdraw as counsel which the court denied. Neither Citicorp Mortgage nor Soro is represented by counsel on appeal.

U.S. 1058 (1986); *National Indep. Theatre Exhibitors, Inc. v. Buena Vista Distrib. Co.*, 748 F.2d 602, 609 (1984), *cert. denied*, 471 U.S. 1056 (1985); *In re K.M.A., Inc.*, 652 F.2d 398, 399 (5th Cir. Unit B 1981). This is true even when the person seeking to represent the corporation is an officer or major shareholder. *Palazzo*, 764 F.2d at 1385. Because Citicorp Mortgage is not represented by counsel, it cannot proceed with its appeal. Accordingly, its appeal is dismissed.

Soro is of course entitled to bring an appeal on his own behalf. *See* 28 U.S.C. § 1654. Because the court failed to comply with the notice requirement of Rule 56(c) of the Federal Rules of Civil Procedure, we reverse its judgment as to Soro.

Rule 56(c) states that a motion for summary judgment "shall be served at least 10 days before the time fixed for the hearing." We have interpreted this language to require "10-day advance notice to the adverse party that the motion and all materials in support of or in opposition to the motion will be taken under advisement by the trial court as of a certain day." *Moore v. Florida*, 703 F.2d 516, 519 (11th Cir. 1983); *see also Milburn v. United States*, 734 F.2d 762, 765 (11th Cir. 1984). This is a "bright-line" rule that applies to all litigants, and this court will *sua sponte* reverse when a district court fails to give the required notice. Here, the court failed to give the defendants advance notice of the date on which it was going to consider Citicorp's motion for summary judgment. Accordingly, the court's judgment as to Soro is reversed and remanded for proceedings consistent with this opinion. DISMISSED in part; REVERSED and REMANDED in part.

APPENDIX E

UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

No. 87-5884
Non-Argument Calendar

D.C. Docket No. 85-2960

CITICORP,

Plaintiff-Counter Defendant
Appellee,

versus

CITICORP MORTGAGE COMPANY, INC.,

Defendant-Counter Plaintiff
Appellant.

Appeal from the United States District Court for the
Southern District of Florida

Before HILL, FAY and VANCE, Circuit Judges.

JUDGMENT

This cause came on to be heard on the transcript of the record from the United States District Court for the Southern District of Florida, and was taken under submission by the Court upon the record and briefs on file, pursuant to Circuit Rule 34-3;

ON CONSIDERATION WHEREOF, it is now here ordered and adjudged by this Court that the judgment of the said District Court in this cause be and the same is hereby, DISMISSED in part; REVERSED in part; and that this cause be and the same is hereby REMANDED to said

District Court for further proceedings in accordance with the opinion of this Court.

It is further ordered that defendant-Counter Plaintiff Appellant pay to plaintiff-counter defendant appellee, the costs on appeal to be taxed by the Clerk of this Court.

Entered: June 30, 1988
For the Court: Miguel J. Cortez, Clerk

By: /s/ David Molaud
Deputy Clerk

ISSUED AS MANDATE: AUG 31 1988

APPENDIX F

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

CASE NO. 85-2960-CIV-SPELLMAN

CITICORP,
Plaintiff,

(Filed Oct 9, 1988)

-vs-

LUIS SORO, an individual,
Defendant.

_____/

SUMMARY FINAL JUDGMENT

THIS CAUSE comes before the Court upon Plaintiff CITICORP's ("CITICORP") Motion for Summary Judgment. This action was first brought against CITICORP MORTGAGE COMPANY, INC. (CITICORP MORTGAGE). CITICORP MORTGAGE answered and subsequently filed two counterclaims on October 6, 1986. On March 5, 1987, Plaintiff filed its Amended Complaint adding Defendant, LUIS SORO ("SORO"), as a party defendant. Both defendants filed answers and affirmative defenses to that Amended Complaint. Although SORO was represented by counsel at that time, SORO contiually [sic] attempted to file Motions in his own behalf and on behalf of CITICORP MORTGAGE.

This Court entered Summary Final Judgment against both CITICORP MORTGAGE COMPANY, INC. and SORO and in favor of Plaintiff on September 8, 1988 [sic]. SORO filed a *pro se* appeal on behalf of himself and CITICORP MORTGAGE. The United States Court of Appeal for the Eleventh Circuit dismissed CITICORP MORTGAGE's appeal for lack of jurisdiction and

reversed and remanded this Court's judgment as to SORO. The ground of that reversal was that sufficient notice was not given before summary judgment was entered.

This Court, in a status conference held on August 24, 1988, notified SORO and counsel for plaintiff that it would reconsider the plaintiff's Motion for Summary Judgment as to SORO personally "based upon the record as it existed at the time of the appeal, plus any new materials that the parties submit to this Court within 10 days of this Notice." The Court also issued notice in writing to SORO on that same date and specifically invited SORO to "file any sworn affidavits or other matters bearing on the issues presented in the Plaintiff's Motion for Summary Judgment, that might serve to convince this Court that there are still material issues of fact remaining in this case requiring that this issue be tried." The Court cautioned SORO that all material had to be received within ten (10) days of the date of the notice.

SORO filed a "Brief in Opposition" to the Summary Judgment on August 31, 1988, along with his affidavit. SORO also filed a Counterclaim on August 31, 1988. Plaintiff filed its reply on September 10, 1988, and a Motion to Strike SORO's counterclaim on September 20, 1988. SORO responded to the Motion to Strike on Sept. 23.

FINDINGS OF FACT

1. This is an action for service mark infringement and unfair competiton [sic] arising under the Trademark Act of 1946, as amended (the Lanham Act, 15 U.S.C.

§ 1051 *et seq.*) and under the common law and stautory [sic] law of Florida. This Court has jurisdiction pursuant to 15 U.S.C. § 1121 (actions arising under the Federal Trademark Act) and 28 U.S.C. § 1338(a) (acts of Congress relating to trademarks) and § 1338(b) (pendent jurisdiction over claims of unfair competition and injury to business reputation).

2. This Court also has diversity jurisdiction under 28 U.S.C. § 1332. Plaintiff is incorporated under the laws of the State of Delaware and is duly authorized to do business in the State of New York. Defendant is a private individual residing in Florida.

3. This Court has venue pursuant to 28 U.S.C. § 1391. All defendants reside in Miami, Florida, and the alleged acts of trademark infringement occured [sic] in Miami, Florida.

4. SORO has used the name CITICORP MORTGAGE COMPANY, INC. since 1981 and is so registered with the Florida Secretary of State. At the time SORO formed his corporation and registered the name CITICORP MORTGAGE with the State of Florida, Plaintiff did not have a Florida office, although it was a nationally known business. Plaintiff did not directly enter the Florida market until 1984.

5. Plaintiff has used the name CITICORP since 1971 and officially changed its name to Citicorp in 1976. Plaintiff obtained its initial registration for CITICORP in 1974, and CITICORP and Design in 1977, both marks being incontestable. Plaintiff also owns several composite marks that include CITICORP.

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8. The mark "CITICORP" is not a generic word but is a combination of a fanciful word "citi" combined with the abbreviation for the word corporation, "corp". "CITICORP" is not found in any dictionary and the combination itself is a fanciful word.

9. The name CITICORP, as it appears in use by both Plaintiff and SORO, is identical, although the logos accompanying the name differ.

10. Both Plaintiff and SORO are presently engaged in the business of providing residential and commerical [sic] mortgages to customers in the Miami area. Both parties have an office in the Miami Beach and service that area.

11. Both plaintiff and SORO advertise in the Miami area through the use of flyers, signage, newspaper inserts, business cars [sic], stationery and Yellow Pages listings.

12. Actual confusion either exists or is likely to exist regarding the use of the name CITICORP by SORO. The name used by the Plaintiff and the name used by SORO are substantially identical. SORO has received both telephone calls and mail directed to Plaintiff.

CONCLUSIONS OF LAW

Plaintiff moved for summary judgment on all four counts of its Complaint based on infringement of its "CITICORP" mark. Plaintiff alleged that SORO's use of the name "CITICORP" for his residential and commerical [sic] mortgage business constituted: 1) infringement of

Plaintiff's incontestable federal registrations for "CITICORP;" 2) false designation of origin under 15 U.S.C. § 1125(a); 3) common law unfair competition; and 4) injury to Plaintiff's business reputation under § 495.151, Florida Statutes.

Summary judgment is appropriate in trademark cases, although "each case must be decided upon its particular facts. . . . " *Beef/Eaters Restaurants, Inc. v. James Burrough Ltd.*, 398 F.2d 637, 638 (5th Cir. 1985).[1] Summary judgments are recognized as "a very useful device to avoid aplenary [sic] trial." *Id.* at 640.

The Court of Appeals for the Eleventh Circuit considers seven elements in determining trademark or service mark infringement; 1) the type of trademark; 2) the similarity of the design; 3) the similarity of product; 4) the identity of retail outlets and purchasers; 5) the identity of advertising media used; 6) the defendant's intent; and 7) actual confusion. *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 972 (11th Cir. 1983).

1) Type of Trademark

A key element in determining the protection to be afforded to any mark is "[t]he strength and distinctiveness" of that mark. *John H. Harlan Co. v. Clarke Checks, Inc.*, 711 F.2d at ___. "Strong marks are widely protected,

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[1] In *Banner v. City of Prichard*, 661 F.2d 1206, 1209 (11th Cir. 1981) (*en banc*), the 11th Circuit adopted as binding precedent all decisions of the former 5th Circuit handed down prior to the close of business on September 30, 1981.

as contrasted to weak marks." *Id.* at ___. The mark "CITICORP" is a combination of a fanciful word "citi" combined with the abbreviation for the word corporation, "corp". "CITICORP" is not found in any dictionary, and therefore must be considered a fanciful word.

The Eleventh Circuit found that a similar word "CITIBANK," which is owned by Plaintiff's subsidiary, was not generic. *Citibank, N.A. v. Citibanc Group, Inc.*, 724 F.2d 1540 (11th Cir. 1984). This Court reaches the same conclusion in regards to CITICORP, a very similar name.

Plaintiff has used the name CITICORP since 1971 and officially changed its name to Citicorp in 1976. Plaintiff obtained its initial registration for CITICORP in 1974, and CITICORP and Design in 1977, both marks being incontestable. Plaintiff also owns several composite marks that include CITICORP.

These above facts compel this Court to conclude that CITICORP is a strong mark that deserves equally strong protection. Because Plaintiff's registrations are incontestable, CITICORP cannot be challenged as merely descriptive, but only if probative evidence shows that it is generic. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189 (1985). There has been no such probative evidence offered that supports SORO's contention that CITICORP is a generic term. The fact that the words "city" and "corp" are often used, albeit independently of each other, does not tend to prove that this precise combination of the two words, with city spelled "citi," is a generic term.

2) Similarity of the Design

Defendant's use of the name CITICORP is identical to Plaintiff's registered mark. The print is exactly the same and the name, as printed, appears identical.

SORO argues that the logo used in conjunction with CITICORP differs and therefore the marks are not similar. The issue in this case, however, is the use of the name CITICORP and here, the name is identical. The fact that the logos differ matters little because it is the name that is distinctive and not the accompanying logo.

3) Similarity of Product

Both the Plaintiff and SORO offer residential and commercial mortgages. Although the Plaintiff offers a much broader range of financial services, SORO's use of CITICORP is directly tied to services that both companies provide – residential and commercial mortgages.

4) Identity of Retail Outlets and Purchasers

Both Plaintiff and SORO offer residential and commerical [sic] mortgages in the Greater Miami area. Thus, it can be concluded that they have identical customers. Athough [sic] Plaintiff has many branch offices, one of those branch offices is located in the Miami Beach area. SORO has only one office, also located in the Miami Beach area. Thus, again, there is a significant overlap of service area.

5) Identity of Advertising Media Used

Again, while Plaintiff's use of advertisement is much broader than SORO's, there is significant overlap in the

local area. Both advertise in the Miami area through the use of flyers, signage, newspaper inserts, business cars [sic], stationery and Yellow Pages listings. Therefore, the identity of advertising media is substantially identical in this local area.

b) Defendant's Intent

SORO has testified that he did not know of Plaintiff's use of the name "CITICORP" when he named his company. Instead, he claims that he picked the word "citi" based on nicknames of old girlfriends, and "corp" to signify red blood corpusles [sic]. At the same time, SORO argues that the name "citicorp" is obviously generic and partly geographical and therefore cannot be protected as a tradename. While SORO's explanation of his name "citicorp" strains this Court's imagination (and most likely would strain that of any reasonable person), SORO's own explanation points up the fact that "CITICORP" is not a generic term and, in fact, is fanciful. SORO himself points out the fact that he did not use the name as either a generic or geographical term. CITICORP as it is used by both parties, therefore, is a fanciful name, and accordingly, a strong mark entitled to broad protection. SORO's assertion that he did not adopt the name CITICORP in an attempt to cause confusion is not credible; however, even if it were, this factor is more than outweighed by the other factors that are considered.

SORO argues that Plaintiff was not allowed into the South Florida market until four years after he began using the name CITICORP, in 1984. Plaintiff is, however, a nationally known and recognized business and its name

CITICORP is also nationally known and recognized. It is impossible to believe that a person in the same type of business would not have known of such a prominent company.

7) Actual Confusion

SORO admitted that he has received both telephone calls and mail directed to Plaintiff. SORO points out that it is not unusual for one business to receive mail for another. This may be true, but it is unlikely to occur in the absence of some sort of confusion. Thus, SORO's own testimony shows that confusion, or at least the likelihood thereof, does exist.

All of the factors considered above clearly favor Plaintiff. "[T]he record as a whole could not lead a rational trier of fact to find for the nonmoving party, there is no 'genuine issue for trial' " and summary judgment is appropriate. *Matsushita Electric Industrial Co. v. Zenith Radio Corp.*, 475 U.S. 317, (1986). The above findings present no genuine issue as to any material fact and therefore require that the Court enter summary judgment for Plaintiff for the counts alleging infringement of Plaintiff's federal registrations, false designation of origin under 15 U.S.C. § 1125(a), and common law competition [sic]. Additionally, the evidence clearly shows that SORO's use of the name CITICORP dilutes Plaintiff's CITICORP mark. Summary judgment is therefore also proper for the count alleging violation of Florida's Anti-Dilution Statute.

SORO'S COUNTERCLAIM

SORO attempted to file a Counterclaim on August 31, 1988. SORO argues that this Counterclaim is allowed under the Rules because the Court in its Notice of Summary Judgment stated that it would consider the Motion for Summary Judgment "based upon the record as it existed at the time of the appeal, plus any new materials that the parties submit to this Court within 10 days of this Notice." SORO has obviously misunderstood this Court. The new materials referred to were only those going to the issue of Summary Judgment. SORO was previously represented by counsel. Counsel filed a [sic] almost identical counterclaim on behalf of the corporate defendant, CITIBANK MORTGAGE. No counterclaim was filed on behalf of SORO. At this point, such a counterclaim is completely untimely and will not be allowed. If SORO wished to have filed a counterclaim, the appropriate time would have been at the time the other counterclaim was filed. There has been no showing that the failure to add SORO's counterclaim within the time limits prescribed by Rule 15(a), Federal Rules of Civil Procedure (1988), was the result of "oversight, inadvertence, or excusable neglect," or that "justice requires" allowing this Counterclaim to be filed now.

Further, even if this Court were to allow the Counterclaim, SORO personally has no standing to bring this claim. All of the alleged injuries were to the corporate entity, CITICORP MORTGAGE, and not to SORO personally. *See National Independent Theatre Exhibitors, Inc. v. Buena Vista Distribution*, 748 F.2d 602, 608 (11th Cir. 1984); *Palazzo v. Gulf Oil Corp.*, 764 F.2d 1381, 1386-87 (11th Cir.

1985). These matters have been dealt with in the Summary Judgment issued against CITICORP MORTGAGE on September 8, 1987. This Court also points out that the granting of this Summary Judgment suggests that SORO's counterclaims would have been unsuccessful in any case.

USE OF NAME CITICORP

When this Court granted Summary Judgment against CITICORP MORTGAGE on September 8, 1987, CITICORP MORTGAGE was directed to cease all infringing activities, to change the corporate name and to deliver all infringing material for destruction. This Court informed SORO at the August 24, 1988, hearing that when the mandate from the 11th Circuit was received, this Court would issue an Order directing SORO, as the representative of CITICORP MORTGAGE, to initiate a change with regard to that name in accordance with this Court's summary final judgment. The Court went on to explicitly warn SORO that in the event that CITICORP MORTGAGE failed to abide by that Order, this Court would hold SORO responsible and would initiate contempt proceeding by way of civil contempt against the officer to whom that Order was and is directed, to wit, SORO. SORO was told at that time that he would have ten (10) days from the date of this Court's Order to conform to the Summary Judgment dated September 8, 1987, and change the name of the corporation on the records of the Secretary of State's Office for the State of Florida.

The mandate was received from the Eleventh Circuit on September 8, 1988. Therefore, SORO has ten days from

the date of this Order to comply with this Court's instructions contained in the September 8, 1988, Order and given to SORO in open court on August 24, 1988. Failure to do so will result in SORO being held in civil contempt.

Accordingly, it is hereby

ORDERED AND ADJUDGED that the Plaintiff's Motion for Summary Judgment is GRANTED. It is further ORDERED that the Counterclaim filed by SORO is DISMISSED as untimely, and for lack of standing. Defendant SORO, as sole stockholder and officer of CITICORP MORTGAGE COMPANY, INC. is hereby directed to initiate a name change for CITICORP MORTGAGE and to comply with the other directives contained in this Court's Summary Final Judgment dated September 8, 1987, within ten (10) days of the date of this Order.

DONE AND ORDERED in Chambers at Miami, Florida this 6 day of Oct, 1988.

/s/ Eugene P. Spellman
UNITED STATES DISTRICT JUDGE

cc: all counsel of record

APPENDIX G

UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	*Citicorp
Serial No:	*75462565
Mark:	*Citigroup
Class:	*36
Allowed:	April 18, 2000
Our Ref:	*14345/1280

STATEMENT OF USE

Box ITU
FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virgina 22202-3513

Applicant is the owner of the mark sought to be registered and has adopted and is now using in commerce the above mark on or in connection with all goods and/or services identified in the Notice of Allowance for the application and request that said mark be rigistered in the United States Patent and Trademark office on the Principal Register established by the Act of July 5, 1946.

The mark was first used on the goods or services anywhere at least as early

as April 6, 1998 and in commerce at least as early as October 8, 1998.

One speciemen showing the mark as currentely used in commerce is presented herewith.

"Express Mail" mailing lable No. TB3192942 28 U S Date of Deposit June 15, 2000. I hereby certify that this paper or fee is being deposited with the United States Postal Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner Trademarks, 2900 Crystal Drive, Arlington, Virgina 22202-3513.

Delayne Bell

DECLARATION

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the owner; and all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true. By: Anne Moses